

104<sup>TH</sup> CONGRESS  
1<sup>ST</sup> SESSION

# H. R. 1733

To amend title 35, United States Code, to provide for early publication of patent applications, to provide provisional rights for the period of time between early publication and patent grant, and to provide a prior art effect for published applications.

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## IN THE HOUSE OF REPRESENTATIVES

MAY 25, 1995

Mr. MOORHEAD (for himself and Mrs. SCHROEDER) introduced the following bill; which was referred to the Committee on the Judiciary

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## A BILL

To amend title 35, United States Code, to provide for early publication of patent applications, to provide provisional rights for the period of time between early publication and patent grant, and to provide a prior art effect for published applications.

1       *Be it enacted by the Senate and House of Representa-*  
2       *tives of the United States of America in Congress assembled,*

3       **SECTION 1. SHORT TITLE.**

4       This Act may be cited as the “Patent Application  
5       Publication Act of 1995”.

1 **SEC. 2. EARLY PUBLICATION.**

2 Section 122 of title 35, United States Code, is  
3 amended to read as follows:

4 **“§ 122. Confidential status of applications; publica-**  
5 **tion of patent applications**

6 “(a) Except as provided in subsection (b), applica-  
7 tions for patents shall be kept in confidence by the Patent  
8 and Trademark Office and no information concerning the  
9 same given without authority of the applicant or owner  
10 unless necessary to carry out the provisions of any Act  
11 of Congress or in such special circumstances as may be  
12 determined by the Commissioner.

13 “(b)(1) Subject to paragraph (2), each application for  
14 patent, except applications for design patents under chap-  
15 ter 16 of this title and provisional applications filed under  
16 section 111(b) of this title, shall be published, in accord-  
17 ance with procedures as determined by the Commissioner,  
18 as soon as possible after the expiration of a period of 18  
19 months from the earliest filing date for which a benefit  
20 is sought under this title, except that an application that  
21 is no longer pending shall not be published and an applica-  
22 tion that is subject to a secrecy order pursuant to section  
23 181 of this title shall not be published. An application may  
24 be published earlier than the above date at the request  
25 of the applicant. No information concerning published pat-  
26 ent applications shall be made available to the public ex-

1 cept as the Commissioner shall determine. Notwithstand-  
2 ing any other provision of law, a determination by the  
3 Commissioner to release or not to release information con-  
4 cerning a published patent application shall be final and  
5 nonreviewable.

6 “(2) Upon request, an application will not be pub-  
7 lished in accordance with paragraph (1) until 3 months  
8 after the Commissioner makes a notification to the appli-  
9 cant under section 132 of this title. Applications filed pur-  
10 suant to section 363 of this title, applications asserting  
11 priority under section 119 or 365(a) of this title, and ap-  
12 plications asserting the benefit of an earlier application  
13 under section 120, 121, or 365(c) of this title shall not  
14 be eligible for a request pursuant to this paragraph. Fur-  
15 thermore, the applicant shall certify that the invention dis-  
16 closed in the application was not or will not be the subject  
17 of an application filed in a foreign country. A request  
18 under this paragraph shall only be available to an inde-  
19 pendent inventor who has been accorded status under sec-  
20 tion 41(h) of this title. The Commissioner may establish  
21 appropriate procedures and fees for a request in accord-  
22 ance with this paragraph.”.

1 **SEC. 3. TIME FOR CLAIMING BENEFIT OF EARLIER FILING**  
2 **DATE.**

3 (a) IN A FOREIGN COUNTRY.—Section 119(b) of title  
4 35, United States Code, is amended to read as follows:

5 “(b) No application for patent shall be entitled to this  
6 right of priority unless a claim therefor and a certified  
7 copy of the original foreign application, specification and  
8 drawings upon which it is based are filed in the Patent  
9 and Trademark Office at such time during the pendency  
10 of the application as required by the Commissioner. The  
11 Commissioner may consider the failure of the applicant  
12 to file a timely claim for priority as a waiver of any such  
13 claim. The certification of the original foreign application,  
14 specification and drawings shall be made by the patent  
15 office of the foreign country in which filed and show the  
16 date of the application and of the filing of the specification  
17 and other papers. The Commissioner may require a trans-  
18 lation of the papers filed if not in the English language  
19 and such other information as he deems necessary.”.

20 (b) IN THE UNITED STATES.—Section 120 of title  
21 35, United States Code, is amended by adding at the end  
22 thereof the following:

23 “The Commissioner may determine the time period during  
24 the pendency of the application within which an amend-  
25 ment containing the specific reference to the earlier filed  
26 application shall be submitted. The Commissioner may

1 consider the failure to timely submit such an amendment  
2 as a waiver of any benefit under this section.”.

3 **SEC. 4. PROVISIONAL RIGHTS.**

4 Section 154 of title 35, United States Code, is  
5 amended by adding the following new subsection:

6 “(d) PROVISIONAL RIGHTS.—In addition to other  
7 rights provided by this section, a patent shall include the  
8 right to obtain a reasonable royalty from any person who,  
9 during the period from publication of the application for  
10 such patent pursuant to section 122(b) of this title or from  
11 international publication of an international application  
12 designating the United States until issue of that patent—

13 “(1)(A) makes, uses, offers for sale, or sells in  
14 the United States the invention as claimed in the  
15 published patent application or imports such an in-  
16 vention into the United States; or

17 “(B) if the invention as claimed in the pub-  
18 lished patent application is a process, uses, offers for  
19 sale, or sells in the United States or imports into the  
20 United States products made by that process as  
21 claimed in the published patent application; and

22 “(2) had actual notice or knowledge of the pub-  
23 lished patent application.

24 The right to obtain a reasonable royalty shall not be avail-  
25 able under this subsection unless the invention claimed in

1 the patent is identical to the invention as claimed in the  
2 published patent application. The right to obtain a reason-  
3 able royalty based upon the international publication of  
4 an international application designating the United States  
5 shall commence from the date that the Patent and Trade-  
6 mark Office receives a copy of the international publica-  
7 tion of the international application, unless already com-  
8 municated by the International Bureau, or, if the inter-  
9 national publication of the international application is in  
10 a language other than English, from the date that the Pat-  
11 ent and Trademark Office makes a translation thereof  
12 available to the public. The Commissioner may require the  
13 applicant to provide a copy of the international publication  
14 of the international application and a translation there-  
15 of.”.

16 **SEC. 5. PRIOR ART EFFECT OF PUBLISHED APPLICATIONS.**

17 Section 102(e) of title 35, United States Code, is  
18 amended to read as follows:

19 “(e) the invention was described in—

20 “(1)(A) an application for patent, published  
21 pursuant to section 122(b) of this title, by another  
22 filed in the United States before the invention there-  
23 of by the applicant for patent, or

24 “(B) an international application, published  
25 pursuant to section 122(b) of this title, by another

1       who has fulfilled the requirements of paragraphs (1),  
2       (2), and (4) of section 371(c) of this title before the  
3       invention thereof by applicant for patent, or

4               “(2) a patent granted on an application for pat-  
5       ent by another filed in the United States before the  
6       invention thereof by the applicant for patent, or on  
7       an international application by another who has ful-  
8       filled the requirements of paragraphs (1), (2), and  
9       (4) of section 371(c) of this title before the invention  
10      thereof by the applicant for patent, or”.

11 **SEC. 6. COST RECOVERY FOR PUBLICATION.**

12       The Commissioner shall recover the cost of early pub-  
13      lication required by the amendment made by section 2 by  
14      adjusting the filing, issue, and maintenance fees, by charg-  
15      ing a separate publication fee, or by any combination of  
16      these methods.

17 **SEC. 7. CONFORMING CHANGES.**

18       The following provisions of title 35, United States  
19      Code, are amended:

20               (1) Section 11 is amended in subsection (a)(1)  
21      by inserting “and published applications” after  
22      “Patents”.

23               (2) Section 12 is amended by inserting “pub-  
24      lished applications and” before “patents”.

1           (3) Section 13 is amended by inserting “pub-  
2       lished applications and” before “patents”.

3           (4) The item relating to section 122 in the table  
4       of sections for chapter 11 is amended by inserting  
5       “; publication of patent applications” after “applica-  
6       tions”.

7           (5) The item relating to section 154 in the table  
8       of sections for chapter 14 is amended by inserting  
9       “; provisional rights” after “patent”.

10          (6) Section 181 is amended—

11               (A) in the first paragraph by inserting “by  
12               the publication of an application or” after “dis-  
13               closure”, and “the publication of an application  
14               or” after “withhold”;

15               (B) in the second paragraph by inserting  
16               “by the publication of an application or” after  
17               “disclosure of an invention”;

18               (C) in the third paragraph by inserting  
19               “by the publication of the application or” after  
20               “disclosure of the invention”, and “the publica-  
21               tion of the application or” after “withhold”;  
22               and

23               (D) in the fourth paragraph by inserting  
24               “the publication of an application or” after  
25               “and” in the first sentence.



1 **SEC. 8. PATENT TERM EXTENSION AUTHORITY.**

2 Section 154(b) of title 35, United States Code, is  
3 amended to read as follows:

4 “(b) TERM EXTENSION.—

5 “(1) BASIS FOR PATENT TERM EXTENSION.—

6 Subject to the limitations of paragraph (2) of this  
7 subsection, if the issue of an original patent is de-  
8 layed due to—

9 “(A) a proceeding under section 135(a) of  
10 this title,

11 “(B) the imposition of an order pursuant  
12 to section 181 of this title,

13 “(C) appellate review by the Board of Pat-  
14 ent Appeals and Interferences or by a Federal  
15 court where the patent was issued pursuant to  
16 a decision in the review reversing an adverse  
17 determination of patentability, or

18 “(D) an unusual administrative delay by  
19 the Office in issuing the patent,

20 the term of the patent shall be extended for the pe-  
21 riod of delay. The Commissioner shall prescribe reg-  
22 ulations to govern the determination of the period of  
23 delay and the particular circumstances deemed to be  
24 an unusual administrative delay.

25 “(2) LIMITATIONS.—

1           “(A) MAXIMUM PERIOD OF EXTENSION.—

2           The total duration of all extensions of a patent

3           under this subsection shall not exceed 10 years.

4           To the extent that periods of delay attributable

5           to grounds specified in paragraph (1) overlap,

6           the period of any extension granted under this

7           subsection shall not exceed the actual number

8           of days the issuance of the patent was delayed.

9           “(B) MINIMUM PENDENCY BEFORE EX-

10          TENSION AVAILABLE.—No patent shall be ex-

11          tended under this section that has been issued

12          before the expiration of 3 years after the filing

13          date of the application leading to the patent or

14          the commencement of the national stage under

15          section 371 of this title, whichever is later, not

16          taking into account the benefit of any earlier

17          filed application or applications under section

18          120, 121, or 365(c) of this title.

19          “(C) REASONABLE EFFORTS.—The period

20          of extension of the term of a patent under this

21          subsection shall be reduced by a period equal to

22          the time during the processing or examination

23          of the application leading to the patent in which

24          the applicant failed to engage in reasonable ef-

25          forts to conclude processing or examination of

1 the application. The Commissioner shall pre-  
2 scribe regulations establishing the cir-  
3 cumstances that constitute a failure of an appli-  
4 cant to engage in reasonable efforts to conclude  
5 processing or examination of an application.

6 “(D) TERMINAL DISCLAIMER.—No patent  
7 whose term has been disclaimed beyond a speci-  
8 fied date may be extended under this section  
9 beyond the expiration date specified in the dis-  
10 claimer.”.

11 **SEC. 9. LAST DAY OF PENDENCY OF PROVISIONAL APPLI-**  
12 **CATION.**

13 Section 119(e) of title 35, United States Code, is  
14 amended by adding the following at the end: “If the day  
15 that is 12 months after the filing date of a provisional  
16 application falls on a Saturday, Sunday, or Federal holi-  
17 day within the District of Columbia, the period of pend-  
18 ency of the provisional application shall be extended to the  
19 next succeeding secular or business day.”.

20 **SEC. 10. EFFECTIVE DATE.**

21 (a) SECTIONS 2 THROUGH 7.—Sections 2 through 7,  
22 and the amendments made by such sections, shall take ef-  
23 fect on January 1, 1996, and shall apply to all applica-  
24 tions filed under section 111 of title 35, United States  
25 Code, on or after that date, and all applications complying

1 with section 371 of title 35, United States Code, that re-  
2 sulted from international applications filed on or after that  
3 date. The amendment made by section 4 shall also apply  
4 to international applications designating the United States  
5 that are filed on or after January 1, 1996.

6 (b) SECTIONS 8 AND 9.—The amendments made by  
7 sections 8 and 9 shall take effect on the date of the enact-  
8 ment of this Act and shall apply to any application filed  
9 on or after June 8, 1995.

